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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,838	10/22/1999	CHUAN-FA LIU	01017/36263	6047

7590 12/28/2001  
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EXAMINER

ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/422,838

Applicant(s)

LIU ET AL.

Examiner

Shubo "Joe" Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 25-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Amendments*

Applicants' election, with traverse, of Group I (claims 1-16, 24, and 27) and the species designated as nucleotide sequence of SEQ ID NO:33, in Paper # 4, filed 7/30/01, is acknowledged.

Applicants' traversal is on the ground that there would be no search burden on the Office if Groups I, II, IV and V were co-examined. This is not found persuasive because as set forth in the previous Office action, mailed 3/26/01, in addition to the groups being patentably distinct, they are usually published separately in the literature (pages 3 and 4). Therefore, co-examination of all the groups would require formulation of different search strategies for the different groups of invention and would certainly impose undue search burden to the Office. Thus, the restriction requirement is still deemed proper and is made FINAL.

As per election of species requirement set forth in the previous Office action, applicants have elected the compound of SEQ ID NO:33. The only claim reading on the elected species is claim 24. Note that, although claim 24 is dependent from claim 1, the latter claim does not encompass products having an Fc-L2 moiety at N-terminus. Accordingly, claims 1-16, and 27 of the elected Group I are not drawn to the elected species.

In summary, claims 1-34 are currently pending, claim 24 is under examination, and claims 1-23, and 25-34 are withdrawn from further consideration under 37 C.F.R.

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1.142(b) as being drawn to non-elected invention, there being no allowable generic claim. See MPEP 809.02(c)(1).

### ***Priority***

It is brought to applicants' attention that for the purpose of examination, priority has not been granted to the claimed provisional application 60/105,348, filed 10/23/1998, for the elected invention because the claimed provisional application was not filed with a Sequence Listing and/or the computer readable form thereof. As such, the Office is not able to determine whether the elected invention was actually adequately disclosed in the provisional application. If prior art published after the filing of the claimed provisional application but before the filing date of the instant application is cited in this Office action, applicants are requested to provide evidence that the elected invention is indeed disclosed in the claimed provisional application if they wish to contest the citation of the intervening prior art.

### ***Specification***

The specification is objected to because of the following:

Note the attached Notice of Draftsperson's Patent Drawing Review. Applicants are hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Applicants are required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

***Claim Rejections-35 USC § 112***

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Claim 24 is rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is rejected because it is dependent from non-elected claim 1 and the metes and bounds of claim 24 is thus unclear.

The rejection would be overcome and the elected species would be allowable if claim 24 is amended to be an independent claim.

Enclosed please find, *inter alia*, a copy of the PTO-1449 with reference(s) lined through and not considered because (1) for the US patents, names of inventors, class and subclass on the PTO-1449 are not filled in and (2) for the non-patent reference(s), copies are not provided to the Office. If applicants wish consideration of the reference(s), a copy of each of the lined-through reference(s) has to be provided to the Examiner.

***Conclusion***

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO

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Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D.



MICHAEL BORIN, PH.D.  
PRIMARY EXAMINER

